

### **REMARKS**

The above-identified Office Action dated March 4, 2008, contained a final rejection of claims 1-28. Claim 1 has been amended in an effort to **clarify** claim 1. Amended claim 1 clearly does **not** require a new search by the Examiner because the new language is included in the claims for clarification purposes only. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Thus, it is respectfully requested that the amendments to claim 1 be entered despite the finality of the present rejection.

### **GROUND OF REJECTION**

The Office Action rejected claims 1-2, 13, 24, 25 and 27-28 under 35 U.S.C. § 102(b) as being anticipated by Lee et al. (U.S. Patent Publication No. 2003/0193593). The Office Action rejected claims 3-9, 14-20 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Kinjo et al. (U.S. Patent No. 6,631,208). The Office Action rejected claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Horie et al. (U.S. Patent No. 6,480,624). The Office Action rejected claims 21-22 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Kinjo et al. and further in view of Horie. The Office Action rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Kinjo et al. in further view of the Examiner's Official Notice. The Office Action rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Kinjo et al. in view of Kinjo et al. in further view of the Examiner's Official Notice.

### **ARGUMENT**

**A. The rejection of claims 1-2, 13, 24, 25 and 27-28 under 35 U.S.C. § 102(b) should be withdrawn because these claims contain features that are not disclosed by the cited Lee et al. reference.**

On page 3 of the March 4, 2008 Final Office Action, the Examiner rejected claims 1-2, 13, 24, 25 and 27-28 as being anticipated by Lee et al.

This rejection under 35 U.S.C. § 102(b) should be withdrawn because all of the features of the Applicants' claimed invention are not disclosed, taught or suggested by Lee et al. According to the case law, the MPEP and the U.S. Code, anticipation requires "...that each and every element of the claimed invention be

disclosed in the prior art." In addition, the cited reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. 35 U.S.C. §102; Akzo N.V. v. United States Int'l Trade Comm'n, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), **cert. denied**, 482 U.S. 909 (1987). MPEP Section 706.

Specifically, although Lee et al. disclose X-Y addressable active pixel sensors, this is very different from the Applicants' claimed invention. For example, Lee et al. is missing the Applicants' claimed accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, **wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them**, respectively. In contrast, Lee et al. use serial shift registers to select image windows for the active sensors, unlike the Applicants' claimed invention, which has different physical circuitry addressing and control lines going to them. Consequently, because the Lee et al. reference is missing at least one feature of the claimed invention, the anticipation rejection must be withdrawn. *MPEP 2131*.

**B. The rejections of the rest of the claims under 35 U.S.C. § 103(a) should be withdrawn because the claims contain features that are not disclosed, taught or suggested by the combined cited references.**

All of the rejections under 35 U.S.C. § 103(a) should be withdrawn because all of the features of the Applicants' claimed invention are not disclosed, taught or suggested by any combination of the cited references.

According to case law and the MPEP, all of the claimed elements of an Applicant's invention **must be considered**. (*In re Kotzab*, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP 2143*.) [*emphasis added*]. If **one** of the elements of the Applicant's invention is missing from or not taught in the cited references and the Applicant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP 2143.03*). The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Specifically, Kinjo et al. merely disclose a digital laboratory system 10 (see FIG 1) for performing red-eye correction on digital images and Horie et al. simply disclose a system for discriminating color using a luminance calculator (see Abstract

of Horie et al.). In any combination, the references are still missing the Applicants' claimed accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively. As such, since the combined cited references are missing at least one feature of the claimed invention, the obviousness rejections must be withdrawn.

**C. The rejections of the claims under 35 U.S.C. § 103(a) should be withdrawn because even though the combined references do not disclose, teach, or suggest all of the features of the Applicants' claimed invention, the references should not be considered together because the Kinjo et al. reference teaches away from the Applicants' claimed invention.**

MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

With regard to Kinjo et al., FIG. 1 of Kinjo et al. explicitly discloses a line CCD 30 included within a line CCD scanner 14. Line CCD 30 of Kinjo et al. is conventional in nature such that if line CCD 30 were to be read (i.e., if output were to be generated by line CCD 30), then all pixels of line CCD 30 of Kinjo et al. would be read/output. In other words, it would be impossible for less than all of the pixels of line CCD 30 of Kinjo et al. to be read from (output by) line CCD 30. The output of line CCD 30 of Kinjo et al. is converted from analog to digital by A/D converter 32, with the output of A/D converter 32 representing the output of line CCD scanner 14.

Consequently, the function and operation of Kinjo et al. clearly would be destroyed if the Applicants' claimed accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the

image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively were used.

This is because the line CCD 30 of Kinjo et al. cannot have different physical circuitry addressing and control lines going to the pixels. As a result, Kinjo et al. cannot read/output less than all of its pixels, like the Applicants' claimed invention, where a pixel-differentiated image sensor is used for which member-pixels of a subset of the entire set of pixels are individually addressable, the image sensor being controllable to read less than all of the pixels without having to read all of the pixels.

Therefore, the proposed modification or combination would render Kinjo et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Kinjo et al. being modified if Kinjo et al. used the Applicants' claimed pixel-differentiated image sensor with pixels that are individually addressable and were to access a first set of sampling photo-sensing pixels of the image sensor and access a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively. In fact, Kinjo et al. cannot be combined with any reference that reads individually addressable pixels because the pixels in Kinjo et al. are unquestionably not intended to be individually addressable and are only for group processing purposes (see Abstract, Summary and FIG. 1 of Kinjo et al.).

As a result, this "teaching away" prevents the Kinjo et al. reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicants' claimed elements are not disclosed, taught or suggested by the combined references and because Kinjo et al. teach away from the Applicants' claimed invention, Kinjo et al. cannot be used as a reference alone or in combination with other references, and hence, the Applicants submit that the rejections should be withdrawn. *MPEP 2143*.

**D. Among other reasons, the rejections of the claims under 35 U.S.C. § 103(a) should be withdrawn because the Examiner used impermissible hindsight when the claims were rejected.**

It is well-settled law that there must be a basis in the references for combining or modifying the references. Namely, the Examiner **cannot** use a "tack-on" approach to arbitrarily "pick and choose" elements from numerous references and combine these elements using hindsight. Any combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). *[emphasis added]*.

Moreover, "[T]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar "...the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses numerous references. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). *[emphasis added]*. Since the Examiner's rejection is unquestionably based on hindsight, the rejection is improper and must be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.

Even if the references in question seem relatively similar "...the opportunity to judge by hindsight is particularly tempting. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here.

This is because **clearly Kinjo et al. teach away from the claimed invention** and any combination of the cited references do not disclose, teach or suggest accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicants' invention obvious and the rejections are

improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this teaching away by Kinjo et al. and the failure of the cited references in any combination to disclose, suggest or provide motivation for the Applicants' claimed invention, indicates a lack of a prima facie case of obviousness (MPEP 2143).

Last, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

#### **CONCLUSION**

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, the Applicants respectfully request reversal of the rejections of the claims. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns.

Please note that all correspondence should continue to be directed to:

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